

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

HEENEY et al.

Examiner: Duc Truong

Serial No.: 10/661,812

Group Art Unit: 1711

Filed: September 15, 2003

Confirmation No: 7389

Title: MONO-, OLIGO- AND POLY(3-ALKYNYLTHIOPHENES) AND THEIR USE AS CHARGE TRANSPORT MATERIALS

REPLY BRIEF UNDER 37 C.F.R. §41.41

Mail Stop: Appeal Brief

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

SIR:

This Reply Brief is submitted under 37 C.F.R. §41.41 in response to the Examiner's Answer, mailed November 21, 2007. Appellants maintain their reliance upon their Brief filed August 10, 2007. The following points are made for emphasis or clarification of points made in the Brief in light of the comments thereon in the Examiner's Answer and/or are made in response to new points of argument raised in the Examiner's Answer.

- 1) The Examiner's Answer states (page 2, part (6)) that "the rejection made using Chem Abstract 135:153178 and 130:197214 have been withdrawn from consideration." Appellants will assume this means that the previous rejection of claims 1-6, 10, 11 and 14-15, on appeal, under 35 U.S.C. §102(b), as being anticipated by Chem Abstract 135:153178 ("Hayashi") or Chem Abstract 130:197214 ("Salzner"), is withdrawn, unless there is an indication otherwise.
- 2) Appellants respectfully submit that the Examiner's Answer misinterprets the arguments in the Brief based on the disclosure at page 14 (i.e., on the third and fourth pages of the Brief). Appellants admit that there is not literal support for the

proviso. Instead, appellants argument based on support being reasonably provided by the disclosure at page 14, paragraph [0035], was that a preference is shown for R^1 being an alkyl group which is not $-SiR^0R^{00}$ -substituted and is not an aryl group or heteroaryl group. Appellants submit that the recited preferences at page 14, paragraph [0035], can be viewed individually, i.e., the preference for R^1 is separate from the preferences for each of the other variables. That is, the preference for R^1 is not conditioned on $n = 2$. Such a conclusion that the paragraph pertains to separate preferences rather than all being conditioned on the other, is supported by the fact that not all the variables appear in the compounds (e.g., Ar and the X groups). Thus, they need to be viewed as a separate preferences. In any event, for the reasons below, appellants believe the proviso is supported under the case law.

- 3) The Examiner's Answer fails to address appellants' arguments on the fourth and fifth pages of the Brief that the case law (e.g., In re Johnson, 194 USPQ 187 (CCPA 1977)) supports that a narrowing proviso of small scope has support in a disclosure even absent any literal support for the proviso.

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Dated January 15, 2008

For the above reasons and the reasons set forth in Appellants' Brief, it is submitted that the decision of the Examiner finally rejecting claims 1-6, 10, 11, 14 and 15, on appeal, is in error and should be reversed.

Respectfully submitted,

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